

## **REMARKS**

**[0003]** Applicant respectfully requests reconsideration and allowance of all of the claims of the application. Claims 1-7, 10-23, and 26 are presently pending. Claims amended herein are 1, 2, 3, 11, 17, 19, and 20. Claims withdrawn or cancelled herein are 8, 9, 24, and 25 (cancelled). New claims added herein are none.

### **Statement of Substance of Interview**

**[0004]** The Examiner graciously talked with me—the undersigned representative for the Applicant—on Jan. 11<sup>th</sup> 2008. Applicant greatly appreciates the Examiner's willingness to talk. Such willingness is invaluable to both of us in our common goal of an expedited prosecution of this patent application.

**[0005]** During the interview, I discussed how the claims differed from the cited art, namely Fenwick. Without conceding the propriety of the rejections and in the interest of expediting prosecution, I also proposed several possible clarifying amendments. No agreement was reached during the interview.

**[0006]** Applicant herein amends the claims in a manner similar to that discussed during the interview. Accordingly, Applicant submits that the pending claims are allowable over the cited art of record for at least the reasons discussed during the interview.

### **Formal Request for an Interview**

**[0007]** If the Examiner's reply to this communication is anything other than allowance of all pending claims, then I formally request an interview with the Examiner. I encourage the Examiner to call me—the undersigned representative for the Applicant—so that we can talk about this matter so as to resolve any outstanding issues quickly and efficiently over the phone.

**[0008]** Please contact me or my assistant to schedule a date and time for a telephone interview that is most convenient for both of us. While email works great for us, I welcome your call to either of us as well. Our contact information may be found on the last page of this response.

### **Claim Amendments**

**[0009]** Without conceding the propriety of the rejections herein and in the interest of expediting prosecution, Applicant amends claims 1, 2, 3, 11, 17, 19, and 20 herein.

**[0010]** Applicant amends claims to clarify claimed features. Such amendments are made to expedite prosecution and more quickly identify allowable subject matter. Such amendments are merely intended to clarify the claimed features, and should not be construed as further limiting the claimed invention in response to cited art.

[0011] Further, no new matter is added by these amendments. The amendments are fully supported throughout the original drawings, and specification including the original claims.

**Expectation that the Next Action will not be Final**

[0012] Applicant submits that all pending claims are in condition for allowance. If the examiner feels otherwise and believes that another action on the merits is necessary, then Applicant expects such an action would be Non-Final.

[0013] According to 37 CFR § 1.113 and MPEP 706.07, the "examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal." "The invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied."

[0014] In accordance with 37 CFR § 1.113 and MPEP 706.07(a), Applicant respectfully submits that finality would be premature for the next action for at least the following reason:

- The Applicant took no action (e.g., amendment or filing of an IDS with a fee) herein that necessitates that the Examiner perform a new search or introduce a new ground of rejection.

**No Action necessitating new grounds for rejection or new search**

[0015] The amendments to at least independent claims 1 and 11, and 17 are limited to incorporating the recitation of dependent claims (or are of substantially the same subject matter). Consequently, one or more claims presented herein have already been examined in the Office Action. Furthermore, Applicant explains herein why these already-examined claims differ from the cited art of record. Therefore, in accordance with 37 CFR § 1.113 and MPEP 706.07(a), finality for the next action would be premature.

## **Formal Matters**

**[0016]** This section addresses any formal matters (e.g., objections) raised by the Examiner.

### **Provisional Double-Patenting Rejections**

**[0017]** Based upon a co-pending commonly assigned continuing application, Application No. 11/152,459, the Examiner rejects claims 1-7, 11, 13-17, 19, 20, and 22 on the grounds of non-statutory obviousness-type double-patenting. Without conceding the propriety of the rejection, Applicant submits a terminal disclaimer herewith, to overcome the provisional double-patenting rejections.

## **SUBSTANTIVE MATTERS**

[0018] This section addresses any substantive matters (e.g., rejections) raised by the Examiner.

### **Anticipation Rejections**

[0019] Applicant submits that the anticipation rejections are not valid because, for each rejected claim, no single reference discloses each and every element of that rejected claim.<sup>1</sup> Furthermore, the elements disclosed in the single reference are not arranged in the manner recited by each rejected claim.<sup>2</sup>

### **Based upon Fenwick**

[0020] The Examiner rejects claims 1, 4, 5, 8, 11-13, 15-18, 22, and 24 under 35 U.S.C. § 102(e) as being anticipated by Fenwick, Jr et al (Fenwick). Applicant respectfully traverses the rejections of these claims. Based on the reasons given below, Applicant asks the Examiner to withdraw the anticipation rejection of these claims.

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<sup>1</sup> "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); also see MPEP §2131.

<sup>2</sup> See *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

### Independent Claims 1, 11, and 17

[0021] Each of the independent claims (1, 11, and 17) is similarly amended herein to incorporate claim language from previously pending claim 9. For example Claim 1, presently recites the following:

- the jukebox having a plurality of DVD's containing commercially available titles stored therein

[0022] The Examiner observes (Action, p. 15) the following with regard to Fenwick: "Fenwick teaches the optical disks (Paragraph 0013), but does not explicitly teach that they are in the DVD format." Accordingly, Applicant submits that the anticipation rejections are moot in light of amendments made herein.

### **Obviousness Rejections**

#### **Lack of *Prima Facie* Case of Obviousness (MPEP § 2142)**

[0023] Applicant disagrees with the Examiner's obviousness rejections. Arguments presented herein point to various aspects of the record to demonstrate that not all of the criteria set forth for making a prima facie case have been met.

**[0024]** Amendments made herein to independent claims 1, 11, and 17 incorporate the claim language of previously presented dependent claims 9 and 25. As noted previously, in reference to independent claims 1, 11, and 17, the Examiner observes the following with regard to Fenwick, (Action, p. 15):

"Fenwick teaches the optical disks (Paragraph 0013), but does not explicitly teach that they are in the DVD format."

Therefore, in his reasoning for rejecting previously pending Claims 9 and 25, the Examiner has relied upon Heuvelman for teaching that optical disks are in the DVD format. The Applicant notes the Examiner's observation and appreciates the same. However, Applicant submits that the combination of these references is improper.

#### **No Reason to Combine References**

**[0025]** The Examiner reasons that the two references should be combined stating "that it would have been obvious to one of ordinary skill in the art to modify Fenwick's [menuing system] to include optical discs are in the DVD format, as taught by Heuvelman, for the advantage of providing a larger selection of high quality programming content, that is readily available, widely used and distributed," (Action, p. 15). Applicant submits that this reasoning is improper.

**[0026]** In formulating this reasoning, the Examiner has overlooked the fact that Fenwick's system already incorporates "banks of digital video disk (DVD) players," (para. 0013). Applicant submits that one of ordinary skill in the art would not look to another reference for a solution already provided by Fenwick.



**[0027]** In addition, Applicant submits that the Examiner has used hindsight reasoning for the combination of references using the claims of the instant application as his guide. The asserted advantage of "providing a larger selection of high quality programming" is formulated without the use of the references themselves or reasoning one of ordinary skill in the art.

**[0028]** Indeed, the stated reasoning appears to ignore the clear teaching of Fenwick which states (referring to their system) "The system delivers to the users a variety of types of program material from a variety of sources," (para. 0013). Applicant submits that one of ordinary skill in the art at the time the invention was made would not reason that Fenwick teaches a system lacking in content variety.

**[0029]** Further, the Examiner has not shown how incorporating Heuvelman into Fenwick has advantaged Fenwick according to the asserted reason. Since Fenwick already discloses the incorporation of DVD formatted materials, how is adding DVD formatted material an advantage? The Applicant submits that it is not.

### **No Reasonable Expectation of Success**

**[0030]** Finally, Applicant submits that one of ordinary skill in the art would not have combined the teachings of these references because there is no reasonable expectation of success. Heuvelman discloses a personal video recorder (PVR) for "creating a personalized content information channel for an end-user," (Heuvelman, Para 0005). Fenwick's system is for "distributing video

program material among users of a lodging or similar facility", such as a hotel or motel that "is able to service a plurality of users," (Fenwick, paras. 0004 & 0012).

**[0031]** Applicant submits that one would have no reasonable expectation of success by combining the commercial system of Fenwick, with the personal system of Heuvelman.

**[0032]** In sum, Applicant submits that there is no suggestion, teaching, or reason given by one reference that would give one of ordinary skill in the art reason to combine it with the teachings of the other reference. Accordingly, Applicant asks the Examiner to withdraw the rejection of these claims.

**[0033]** As stated previously, each of the independent claims (Claim 1, 11, and 17) presently recite that DVD formatted materials are stored within the jukebox. Since Fenwick alone does not teach this, and since it is improper to combine Heuvelman to correct this deficiency, Applicant asserts that each of the independent claims is allowable.

*Dependent Claims 2-7, 10, 12-16, 18-23, and 26*

**[0034]** These claims ultimately depend upon independent claims 1, 11, and 17. As discussed above, claims 1, 11, and 17 are allowable. It is axiomatic that any dependent claim which depends from an allowable base claim is also allowable. Additionally, some or all of these claims may also be allowable for additional independent reasons.

### **Dependent Claims**

[0035] In addition to its own merits, each dependent claim is allowable for the same reasons that its base claim is allowable. Applicant requests that the Examiner withdraw the rejection of each dependent claim where its base claim is allowable.

### **Conclusion**

[0036] All pending claims are in condition for allowance. Applicant respectfully requests reconsideration and prompt issuance of the application. If any issues remain that prevent issuance of this application, the **Examiner is urged to contact me before issuing a subsequent Action.** Please call/email me or my assistant at your convenience.

Respectfully Submitted,

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